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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/775,375	01/31/2001	John F. McEntee	10004032-1	7821

7590 09/21/2004

AGILENT TECHNOLOGIES
Legal Department, 51U-PD
Intellectual Property Administration
P.O. Box 58043
Santa Clara, CA 95052-8043

EXAMINER

HANDY, DWAYNE K

ART UNIT	PAPER NUMBER
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1743

DATE MAILED: 09/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 09/775,375	Applicant(s) MCENTEE ET AL.	
	Examiner Dwayne K Handy	Art Unit 1743	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 01 July 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-8 and 10-21 is/are rejected.
- 7) ☒ Claim(s) 9 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

Art Unit: 1743

DETAILED ACTION

Inventorship

1. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

3. Claims 1-8 and 10-17 are rejected under 35 U.S.C. 103(a) as being unpatentable over Besemer et al. (6,140,044) in view of Runyon et al. (5,101,975). Besemer teaches an apparatus for packaging a probe array. The probe array is described in general in column 5. It is comprised of a wafer or chip which may be comprised of a wide variety of materials. The use of an array of DNA on silicon materials is disclosed in column 6. Besemer teaches a wide variety of chip holders for use with the chip array, as well as how to load them, in columns 13-15. All of the chip holder embodiments involve the placement of the chip into a housing which holds the chip (Figures 16A-24). The chip may be sealed into the housing through the use of a cover (2770) which may take the form of an adhesive film (column 15, lines 37-48). As shown in the various Figures cited, the chip may be placed in the housing while leaving room both above and under the chip between the chip and another surface (cover film or bottom of the housing). Besemer teaches fluid retention and delivery to the chip while in the housing via duck billed check valves (septa) in column 14, lines 49-57. Besemer does NOT teach multiple microarrays in a pocket strip having a number of pockets. Besemer teaches a single microarray chip held in a single housing.

Runyon et al. (5,101,975) teach an electronic component carrier. The carrier has a carrier body to handle and protect electronic components. The carrier body has a bottom member with a flat upper surface and a support ledge. The carrier body has a restraint structure which extends over the support surface. The embodiment of their

Art Unit: 1743

component carrier shown in Figures 11, 21 and 24 include a carrier sheet (pocket strip) having a number of pockets for holding elements. These embodiments are described in columns 8 and 18 respectively. The carrier sheet (80) is employed for bulk handling of components and includes elements (holes) on the sides for mating with automated equipment. The Examiner believes this feature meets the limitations of claims 6-8 and 10 since the holes on the sides of the carrier sheet may be detected by a sensor as well as engage complementary features of a mechanical positioning mechanism. A continuous cover tape (96) is shown covering multiple components and holding them in the carrier. It would have been obvious to combine the bulk carrier sheet of Runyon with the teachings of Besemer. One would provide the carrier of Runyon in order to provide the individual chips of Besemer in individual packages while still providing the chips in bulk as taught by Runyon.

Response to Arguments

4. Applicant's arguments, filed 7/1/2004, with respect to the prior art rejections made in the previous Office Action, have been fully considered and are persuasive. The rejection of claims 1-21 has been withdrawn. Please see new grounds of rejection given above.

Allowable Subject Matter

5. Claim 9 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base

Art Unit: 1743

claim and any intervening claims. In claim 9, applicant has claimed a pocket strip with a number of pockets, a number of microarrays in the pockets, a cover strip bonded to the pocket strip sealing the chambers, and regularly spaced electromechanical features that can be detected with an electromechanical positioning mechanism.


Conclusion

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Dwayne K Handy whose telephone number is (571)-272-1259. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jill Warden can be reached on (571)-272-1267. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

DKH
September 17, 2004


Jill Warden
Supervisory Patent Examiner
Technology Center 1700